

tesa AG 642-HCL
3162-St-st**REMARKS****Summary of Amendments Made****35 U.S.C. 103(a) rejection**

Claims 1-18 were rejected by the examiner as being obvious over Chiu (U.S. Patent 5,095,068) in view of Berejka (U.S. Patent 4,332,655).

- (1) In response to the applicants' assertion that Chiu did not teach the applicants' claimed amount and methylol content of phenolic resin, the examiner responded by citing col. 7, line 59 of the Chiu reference which stated that the preferred concentration of phenolic resin is 5-25 phr (parts per hundred resin).
- (2) To address the methylol content, a passage from the Berejka reference was relied upon (col. 5, lines 57-59 - "...heat reactive phenolic resins with 10-12% methylol content can serve as tackifiers...")
- (3) To address the applicants' arguments that Chiu does not teach the amounts of non-thermoplastic elastomer as claimed, the examiner responded "It is the position of the examiner that the amount taught by Chiu, when adjusted to applicants method of measurement at least overlap those claimed instantly."

With regard to the methylol content, it is noted that even if the examiner's arguments were accepted, this still would not address the limitations of claims 13-18 which do not read upon the teachings of Berejka (MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

With regard to the methylol content and claims 1-12, as the basic considerations for applying 35 U.S.C. 103 requires that the claimed invention and the references considered must be considered as a whole (see MPEP page 2100-116, Rev. 1, Feb. 2003), it has not been explained why one of ordinary skill would selectively look to pick one particular element out of the teaching as a whole of the Berejka reference and substitute it into the invention of Chiu or be motivated to do so (it has previously been held

tesa AG 642-HCL
3162-St-st

that "...Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998))

MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990). Moreover, for the Chiu reference, even if it were permissible to selectively cull elements from the prior art as needed, there is some question as to whether the teaching of Berejka can be combined given the difficulties associated with Chiu's invention, e.g. phenolic resin requires at least 3 phr of zinc oxide (see col. 3, line 30 and col. 8, lines 27-29) and there is a delicate balance which must be achieved with respect to the type of oxidizing agent used (see col. 3, lines 31-56 of Chiu). As such, it cannot be presumed that swapping different types of phenolic resins in the teachings of Chiu would not adversely affect the basic and novel characteristics of their invention, i.e. there is no reasonable expectation of success for making the asserted combination of teachings which is required for establishing a *prima facie* case of obviousness.

With regard to point (3), it has previously been held that "The ultimate determination whether an invention would have been obvious under 35 U.S.C. § 103 is a legal conclusion *based on underlying findings of fact.*" see *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). The applicants' previous response with regard to the amount of non-thermoplastic elastomers would appear to have established that the Chiu reference did not teach this amount (or at least raised serious doubts that this amount was taught). While the examiner is not required to accept the arguments proffered by the applicants, the position set forth by the examiner must have some basis in fact. The rebuttal appears more of a hope or presumption that the ranges would somehow overlap not on a factual determination.

If the examiner's position is based on inherency, the examiner is reminded that MPEP 2112 (Requirements of Rejection Based on Inherency, Burden of Proof) states "*The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).....To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*" *In re Robertson*,

Iesa AG 642-HCL
3162-St-st

If the examiner's position is based on optimization of ranges, the examiner is reminded that MPEP 2144.05 section II (Optimization of Ranges) states that "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)." No such recognition has been made.

For the reasons given above, the examiner would be justified in withdrawing the rejections based on Chiu in view of Berejka.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (4 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 15 April 2003

By: Vilma I. Fernandez
Vilma I. Fernandez